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10/509,278	09/27/2004	Noriyuki Yamamoto	450100-04446	7653
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William S. Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151				MORRISON, JAY A
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/509,278	YAMAMOTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jay A. Morrison	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 September 2004.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-53 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-53 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 27 September 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/27/04, 9/23/05.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Remarks***

2. Claims 1-53 are pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-19, 22-30, 33-46, 49-51 and 54 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

As per claims 1-19, 23-30, 34-46 and 50-51, these claims disclose a system or apparatus but do not describe any hardware, which is required for a system claim to be statutory. Accordingly, these system or apparatus claims are rejected as non-statutory for failing to disclose any hardware.

As per claims 22, 33, 49 and 54, these claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a

combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-7, 9-38, 40-49 and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. ('Aoki' hereinafter) (Patent Number 7,107,271) in view of Abecassis (Patent Number 6,011,895).

As per claim 1, Aoki teaches

An information search system having an information processing apparatus and an information search apparatus which is accessed by said information processing apparatus via a network, said information processing apparatus comprising: (see abstract and background)

extraction means for analyzing predetermined information to extract an interest word (keyword common to user history, column 6, lines 48-52)

for obtaining program information about a program; ('for' indicates intended use; Minton v. Nat'l Ass'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003) "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited."

Examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein" clauses; and (C) "whereby" clauses. Therefore intended use limitations are not required to be taught, see MPEP § 2106 Section II(C), MPEP 2111.04 [R-3])

search request means for sending said interest word extracted by said extraction means to said information search apparatus to request a search for said program information corresponding to said interest word; (search for program having common keyword, column 6, lines 53-58)

Aoki does not explicitly indicate “and reception means for receiving said program information from said information search apparatus on the basis of said search request means; said information search apparatus comprising: accumulation means for accumulating said program information; search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information processing apparatus; and transmission means for sending said program information retrieved by said search means to said information processing apparatus”.

However, Abecassis discloses “and reception means for receiving said program information from said information search apparatus on the basis of said search request means;” (keyword analysis linkage to service center, column 15, lines 13-16) “said information search apparatus comprising: accumulation means for accumulating said program information;” (download listings, column 15, lines 15-18) “search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information processing apparatus;” (download listings from various sources, column 15, lines 15-20) “and transmission means for sending said program information retrieved by said search means to said information processing apparatus” (segments assembled and merged by service center and transmitted, column 15, lines 30-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Aoki and Abecassis because using the steps of “and reception means for receiving said program information from said information search

apparatus on the basis of said search request means; said information search apparatus comprising: accumulation means for accumulating said program information; search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information processing apparatus; and transmission means for sending said program information retrieved by said search means to said information processing apparatus" would have given those skilled in the art the tools to improve the invention by selection of a variety of programs by means of a database architecture that would permit keyword searches. This gives the user the advantage of content better matching their requirements.

As per claim 2, Aoki teaches  
said extraction means of said information processing apparatus includes  
morphological analysis means for performing morphological analysis on said  
predetermined information to resolve said predetermined information into said interest  
word. (column 6, lines 54-56)

As per claim 3, Aoki teaches  
said information processing apparatus further comprising database construction  
means for generating a database of said interest word extracted by said extraction  
means. (column 6, lines 38-42)

As per claim 4,  
said information processing apparatus further comprising recording control  
means for controlling the recording of said program on the basis of said program  
information received by said reception means. (column 7, lines 3-6)

As per claim 5,  
said information processing apparatus further comprising display control means  
for controlling the display of said program information received by said reception means.  
(column 8, lines 44-48)

As per claim 6,  
said accumulation means of said information search apparatus includes  
database construction means for making a database by relating said program  
information with said program. (column 6, lines 32-36)

As per claim 7,  
said predetermined information includes at least one of document information,  
preference information associated with said program, and a viewing log of said  
program. (column 6, lines 6-10)

As per claim 9,

Aoki does not expressly show “said program information includes recording start time, recording end time, and channel information for recording said program “.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The content of the program information does not affect the performed steps since it is not functionally involved. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use various timer-recording information because such data does not functionally relate to the steps in the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 10,

    said information processing apparatus acquires said predetermined information from another information processing apparatus. (column 6, lines 50-56)

As per claims 11-19,

    These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-4 and 6-10, respectively, and are similarly rejected.

As per claim 20-22,

These claims are rejected on grounds corresponding to the arguments given above for rejected claim 1, respectively, and are similarly rejected.

As per claim 23,

An information search apparatus comprising: (see abstract and background) accumulation means for accumulating program information associated with a program; (date and start time of program, column 6, lines 57-60)  
reception means for receiving an interest word for obtaining said program information, said interest word being sent from an information processing apparatus; (keyword common to user history, column 6, lines 48-52)  
search means for searching said accumulation means for said program information associated with said interest word received by said reception means.  
(search for program having common keyword, column 6, lines 53-58)

Aoki does not explicitly indicate “and transmission means for sending said program information retrieved by said search means to said information processing apparatus”.

However, Abecassis discloses “and transmission means for sending said program information retrieved by said search means to said information processing apparatus” (segments assembled and merged by service center and transmitted, column 15, lines 30-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Aoki and Abecassis because using the steps of “and transmission means for sending said program information retrieved by said search means to said information processing apparatus” would have given those skilled in the art the tools to improve the invention by selection of a variety of programs by means of a database architecture that would permit keyword searches. This gives the user the advantage of content better matching their requirements.

As per claim 24,

    said interest word is a word obtained by performing morphological analysis on predetermined information on said information processing apparatus. (column 6, lines 54-56)

As per claim 25,

Aoki does not expressly show “said program information contains recording start time, recording end time, and channel information for recording said program”.

    However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The content of the program information does not affect the performed steps since it is not functionally involved. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ

401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use various timer-recording information because such data does not functionally relate to the steps in the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 26,

analysis means for analyzing said program information; (column 6, lines 29-36)  
dictionary generation means for generating dictionary data for relating a genre of said program information with a keyword on the basis of a result of the analysis by said analysis means; (column 7, lines 13-16)

and database generation means for assigning a genre to said program information on the basis of said dictionary data generated by said dictionary generation means and storing said program information with said genre. (column 7, lines 9-12)

As per claim 27,

keyword search means for extracting a keyword from said interest word, acquires a genre corresponding to said keyword by searching said dictionary data on the basis of said keyword, and searching for said program information on the basis of said genre. (column 7, lines 14-18)

As per claim 28,

said dictionary generation means has keyword detection means for detecting a word which is high in cooccurrence in metadata of a particular genre among words included in said metadata, as a keyword of said genre. (column 7, lines 12-16)

As per claim 29,

said dictionary generation means generates said dictionary data by storing, with said keyword, a frequency at which said keyword is detected. (column 5, lines 35-45)

As per claim 30,

said database generation means complements a component which is not included in said program information on the basis of a component contained in said program information. (column 5, lines 26-32)

As per claims 31-33,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claim 30 and are similarly rejected.

As per claim 34,

An information search system having a mobile terminal apparatus, an information processing apparatus connected to said mobile terminal apparatus via a network, and

an information search apparatus which is accessed by said information processing apparatus via said network, said mobile terminal apparatus comprising: (see abstract and background)

generation means for generating timer-recording information for timer-recording a program; (date and start time of program, column 6, lines 57-60)

and first transmission means for sending said timer-recording information generated by said generation means to said information processing apparatus; (transfer program information, column 6, lines 62-64)

said information processing apparatus comprising: extraction means for analyzing said timer-recording information sent from said mobile terminal apparatus to extract an interest word for obtaining program information associated with said program; (keyword common to user history, column 6, lines 48-52)

search request means for sending said interest word extracted by said extraction means to said information search apparatus to request for the search for said program information corresponding to said interest word. (search for program having common keyword, column 6, lines 53-58)

Aoki does not explicitly indicate “and reception means for receiving said program information from said information search apparatus on the basis of said search request means; said information search apparatus comprising: accumulation means for accumulating said program information; search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information

processing apparatus; and second transmission means for sending said program information retrieved by said search means to said information processing apparatus".

However, Abecassis discloses "and reception means for receiving said program information from said information search apparatus on the basis of said search request means;" (keyword analysis linkage to service center, column 15, lines 13-16) "said information search apparatus comprising: accumulation means for accumulating said program information;" (download listings, column 15, lines 15-18) "search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information processing apparatus;" (download listings from various sources, column 15, lines 15-20) "and second transmission means for sending said program information retrieved by said search means to said information processing apparatus" (segments assembled and merged by service center and transmitted, column 15, lines 30-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Aoki and Abecassis because using the steps of "and reception means for receiving said program information from said information search apparatus on the basis of said search request means; said information search apparatus comprising: accumulation means for accumulating said program information; search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information processing apparatus; and second

transmission means for sending said program information retrieved by said search means to said information processing apparatus" would have given those skilled in the art the tools to improve the invention by selection of a variety of programs by means of a database architecture that would permit keyword searches. This gives the user the advantage of content better matching their requirements.

As per claim 35,

    said extraction means includes morphological analysis means for performing morphological analysis on said predetermined information to resolve said predetermined information into said interest word. (column 6, lines 54-56)

As per claim 36,

    said information processing apparatus further comprising recording control means for controlling the recording of said program on the basis of said program information received by said reception means. (column 7, lines 3-6)

As per claim 37,

    said accumulation means of said information search apparatus includes database construction means for generating a database by relating said program information with said program. (column 6, lines 35-40)

As per claim 38,

Aoki does not expressly show “said timer-recording information includes at least one of program name, genre name, and cast name “.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The content of the timer-recording information does not affect the performed steps since it is not functionally involved. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use various timer-recording information because such data does not functionally relate to the steps in the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 40,

said program information contains recording start time, recording end time, and channel information for recording said program. (column 6, lines 57-63)

As per claims 41-46,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 34-36 and 38-40, respectively, and are similarly rejected.

As per claims 47-49,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claims 41 and are similarly rejected.

As per claims 51-54,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 41 and 45, each respectively, and are similarly rejected.

7. Claims 8, 39 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. ('Aoki' hereinafter) (Patent Number 7,107,271) in view of Abecassis (Patent Number 6,011,895) and further in view of Logan et al. ('Logan' hereinafter) (Patent Number 6,199,076).

As per claim 8,

Neither Aoki and Abecassis "said document information is electronic mail"  
However, Logan discloses "said document information is electronic mail" (column 3, lines 48-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Aoki and Abecassis because using the steps of "said document information is electronic mail" would have given those skilled in the art the

tools to improve the invention by providing access to media content in an easy and intuitive way. This gives the user the advantage of a better interface for accessing desired media.

As per claim 39,

Neither Aoki and Abecassis “said timer-recording information is electronic mail” However, Logan discloses “said timer-recording information is electronic mail” (column 3, lines 48-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Aoki and Abecassis because using the steps of “said timer-recording information is electronic mail” would have given those skilled in the art the tools to improve the invention by providing access to media content in an easy and intuitive way. This gives the user the advantage of a better interface for accessing desired media.

As per claim 50,

An information search system having an information processing apparatus and an information search apparatus which is accessed by said information processing apparatus via a network, said information processing apparatus comprising: (see abstract and background)

to extract an interest word for obtaining program information associated with a program; (keyword common to user history, column 6, lines 48-52)

Aoki does not explicitly indicate “search request means for sending said interest word extracted by said extraction means to said information search apparatus to request for the search for said program information corresponding to said interest word; and reception means for receiving said program information from said information search apparatus on the basis of said search request by said search request means, said information search apparatus comprising: accumulation means for accumulating said program information; search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information processing apparatus; and transmission means for sending said program information retrieved by said search means to said information processing apparatus”.

However, Abecassis discloses “search request means for sending said interest word extracted by said extraction means to said information search apparatus to request for the search for said program information corresponding to said interest word;” (keyword analysis linkage to service center, column 15, lines 13-16) “and reception means for receiving said program information from said information search apparatus on the basis of said search request by said search request means, said information search apparatus comprising: accumulation means for accumulating said program information;” (download listings, column 15, lines 15-18) “search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information processing apparatus;” (download listings from various sources,

column 15, lines 15-20) “and transmission means for sending said program information retrieved by said search means to said information processing apparatus” (segments assembled and merged by service center and transmitted, column 15, lines 30-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Aoki and Abecassis because using the steps of “search request means for sending said interest word extracted by said extraction means to said information search apparatus to request for the search for said program information corresponding to said interest word; and reception means for receiving said program information from said information search apparatus on the basis of said search request by said search request means, said information search apparatus comprising: accumulation means for accumulating said program information; search means for searching said accumulation means for said program information associated with said interest word contained in said search request on the basis of said search request sent from said information processing apparatus; and transmission means for sending said program information retrieved by said search means to said information processing apparatus” would have given those skilled in the art the tools to improve the invention by selection of a variety of programs by means of a database architecture that would permit keyword searches. This gives the user the advantage of content better matching their requirements.

Neither Aoki and Abecassis explicitly indicate “extraction means for analyzing electronic mail”.

However, Logan discloses “extraction means for analyzing electronic mail” (segments include email, column 3, lines 48-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Aoki and Abecassis because using the steps of “extraction means for analyzing electronic mail” would have given those skilled in the art the tools to improve the invention by providing access to media content in an easy and intuitive way. This gives the user the advantage of a better interface for accessing desired media.

### ***Conclusion***

8. The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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